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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,182	01/03/2001	Robert Carl Silkey	258/083	2812
27189 7590 12/21/2006 PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101			EXAMINER JANVIER, JEAN D	
			ART UNIT 3622	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/21/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/754,182	SILKEY ET AL.	
	Examiner	Art Unit	
	Jean Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 42-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

The title of the invention is not descriptive so as to help one having ordinary skill in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed. See 37 CFR 1.72.

Information Disclosure Statement

The references to a plurality of web site addresses as shown on PTO Form 1449 does not constitute a proper Information Disclosure Statement (IDS) under 1.56. Applicant should access www.archive.org and print out the pertinent web pages and submit them for consideration in a future correspondence.

Status of the claims

Claims 30-41 were canceled. New claims 42-53 are now pending in the Instant Application.

Claim Rejections - 35 USC § 112

Claims 42 and 48 (including their dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Here, it appears that the claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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It appears that the specification does not expressly support a merge module configured to create an identified event on the calendar (schedule) of events and a reference providing network access to the scheduling module (calendar) or the step of merging a personalized message with a reference providing network access to a scheduling module (calendar).

General Comments

In general, the Applicant's newly added claims, particularly claims 42 and 48, are based on "intended use" recitation. Intended use-type claim limitations are not positive limitations and only require the ability to perform a particular function. The test here is whether the prior art is capable of performing the disclosed tasks or functions, such as **"a scheduling module configured to manage a calendar of events..."**. In the affirmative, the prior art, including the Plainfield's system, is capable of performing the intended tasks and said to "read on" the claim limitations recited therein. **For example, the system disclosed by Plainfield is capable of storing and managing user's data such as a birth date, wedding anniversary date and so on in a calendar file and to retrieve and transmit a birthday message or wedding anniversary message (promotional message) to the user according to a schedule or a calendar when the user's birth date or his wedding anniversary is approaching.**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42, 44-45, 48 and 50-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Plainfield, US Patent 5,893,075.

As per claims 42, 44-45, 48 and 50-51, Plainfield discloses an interactive, customer-accessible data processing system embodied in a programmed personal computer that induces customers of a restaurant, store or other business to enter information (profile information) about themselves into the system database. The information, which may include names, addresses (demographic data), dates and answers to survey questions, is entered into data fields displayed on a display screen coupled to a terminal accessible to the customers. The system enables a business to generate promotional messages tailored to customers based on the customer-entered information (profile). For instance, a business can readily **generate birthday** offer letters **(sending birthday messages or sending promotional birthday messages or offers)** to customers based on their name, address, and birth date simply by selecting an option provided by the system **(or simply by searching the system database for appropriate clients or customers)**. To induce customers to enter the necessary information or profile data, the system flashes an incentive message on the computer or terminal display screen. The message may offer to enter a customer into a drawing or other contest in return for the customer entering the necessary information into the system (See abstract).

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Here, the interactive data processing system, as described above, includes a data entry device such as a personal computer accessible to the customers to enter data about themselves into the system database. The system further comprises a customer database and means for providing a plurality of customer data fields associated with the customer database for storage and later retrieval and use. Customers use the data entry device, such as a keyboard, to enter their data into the data fields and thereby into the customer database. **Means are also included in the system for generating promotional messages such as mailings (personalized mailers) to customers, based on the data (customers' profile) entered by the customer into the customer database.** To stimulate or encourage customers to enter data, the system may include means for inducing customers to enter data about themselves into a customer database, such as generating a message on the computer display screen offering an incentive to the customer for entering such data. **Moreover, the means for generating promotional messages may be constructed to generate letters (personalized mailers) tailored to customers based on their entered data. The bodies of these letters may be stored in a system library and selected as appropriate for the customer, such as birthday greetings, anniversary congratulations, dinner specials, etc.**

In short, the present system includes computerized methods, not limited to the data processing system, for surveying and targeting customers. In a preferred embodiment, the method may include providing a customer database, a plurality of customer database fields and a data entry device for customers to enter profile data into the fields and hence in the customer database. **Promotional messages (birthday message/offer, anniversary, dinner specials, congratulations.....) are then being generated and sent to the customers based on the data**

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entered by the customers (or based on the customers' profile stored in the database).

Moreover, a method or process for inducing customers to enter the profile data, such as by displaying a message on a display screen terminal offering an incentive to a customer for entering such data, is provided.

Col. 1: 55 to col. 2: 27.

Further, data gathered through customer entry may be used to generate promotion messages through another "managerial" option. FIG. 15 is a flow chart of a method of generating promotional customers for customers, based on the data entered into the customer database. A group of customers is requested by a "tagging" as described in conjunction with FIG. 13 (200). The operator then selects an appropriate promotional message such as a letter for the tagged group from a library of letters (202). The library is comprised of letters or other messages created by the operator. To that end, the system provides a variety of screen displays (204) for enabling the operator to create new customer letters for the library from scratch or through copying or editing, to delete letters from the library, or to view the letters in the library before selection. With a letter selected by the operator, the system merges the letters with the tagged group of customers, using information from the appropriate data fields such as name, address and personal dates in fields within the letter (206). The operator then sends the promotional message (208) in an appropriate format such as letter (210), facsimile (212), **electronic mail (214)** or other medium to the customer (216). Alternatively, the operator may export the messages (218) outside the data processing system to external software (220) for a separate mailing or other transmission to customers (col. 7: 19-43).

In short, the system disclosed by Plainfield is capable of storing and managing

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user's data, such as a name, address, birth date, wedding anniversary date and so on, in a calendar file (calendar of events) and retrieving and sending, via mail/letter, facsimile or electronic transmission (electronic means), a birthday message or wedding anniversary message (promotional message) to the user according to a schedule or a calendar when the user's birth date/birthday or his wedding anniversary date is "approaching" (merging module adapted to create a birthday message or promotional message to be sent to the user when an identified event or the user's birthday is approaching based on user's data previously stored in a database calendar file of events-figs. 2, 5 and 15; claims 1-8 and 13-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43 and 49, 46-47 and 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plainfield, US Patent 5, 893,075.

As per claims 43 and 49, 46-47 and 52-53, although Plainfield teaches a system for presenting a personalized message, such as a promotional message, birthday or anniversary message to a user, however, Plainfield does not expressly disclose generating

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a holiday greeting, an appointment or a prescription reminder.

However, it is common practice for a user (sender) to send a post card or greeting card to another user (recipient) for a special event or occasion, wherein the post card contains a personal message written by the sender for the recipient and an advertising message. Furthermore, it is well documented that a sender can electronically create a personal greeting card, containing a personal written message such as a birthday (or anniversary) message and information regarding a special gift, which is subsequently sent to a recipient for his birthday (or anniversary).

Additionally, it is customary for a business such as a car dealership to send a reminder to a customer reminding him that it is time that his identified car have an oil change, for a doctor's office to send an appointment reminder to a patient reminding him of an appointment already scheduled or reminding him to make an appointment for his annual physical. Moreover, it is well supported in the art for businesses to send holiday greeting cards to their customers thanking them for their patronage or business, wherein the greeting cards contain holiday greeting messages and company promotional messages.

Finally, sending a birthday holiday message, an anniversary message, an appointment reminder or prescription reminder or any other type of message to a user is a matter of desires.

("Official Notice" or Public Disclosure)

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above Public Disclosure into the system of Plainfield so as to generate a by a sender (or a business entity) a personalized message, such as, a holiday greeting message, a birthday or anniversary message, an appointment or prescription reminder, to be sent

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to a user recipient based on a special occasion and wherein a unique promotional message may be appended to the personalized message, thereby taking advantage of a special event or occasion to generate and send a personalized correspondence or message to a targeted user recipient, which includes a targeted promotion for a product or service associated with a manufacturer or local vendor and wherein the sender (or business entity) of the personalized correspondence or mailer or mail piece is compensated for distributing the manufacturer's or the local vendor's promotional message to the recipient of the correspondence and wherein the revenues earned by the sender or business entity for disseminating the promotional message help the sender increase his business bottom line or pay for his overheads.

Response To Arguments

Applicant's arguments with respect to the claimed invention have been considered but are moot in view of the new ground(s) of rejection. In other words, Applicant's arguments are based on the new claims and are fully addressed in the above Action. Furthermore, all claims are herein being examined.

Conclusion

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicants are further directed to consult these references.

US Patent 6, 567, 786B1 to Bibelnicks discloses a method, and system for increasing the efficiency of customer contact strategies is disclosed. Customers are analyzed based upon

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historical criteria; a promotional plan (a group of promotion events implemented or to be implemented over a particular time period) is analyzed to determine the effect of each promotion event on the other promotion events in the promotional plan; and, based on this analysis, the optimal promotion stream (a specific subset of the promotional plan to be sent to customers or a group of similar customers) is determined so as to maximize the ROI of the promotional plan as a whole.

US Patent 6, 076, 101 to Kamakura discloses an electronic mail processing system for distributing an e-mail message from a sender to recipients, which encourages the recipients to open, read, and reply to the e-mail message sent from the sender. An original e-mail message sent from a sender via a sender terminal is stored in an outgoing message storage unit. An outgoing mail information registration unit stores a list of recipients to whom the e-mail message should be delivered, as well as storing information on bonus points. A message sending unit encloses bonus point information in the e-mail message and distributes it to the recipients included on the list. Upon receipt of a reply message from one of the recipients, a reception process unit gives a predetermined number of bonus points to the recipient. Each recipient's bonus points are accumulated in a recipient information storage unit, and he/she can redeem his/her bonus points for gifts depending on the accumulated points. This structural arrangement encourages the recipients to open the sender's message and write reply messages thereto in expectation of the redeemable bonus points, thus allowing the original message sender to collect more reply messages from the recipients than normally expected.

US Patent 6,714,916 to Robertson discloses a network-computer-based personal contact manager system, wherein users of networked clients maintain and update a set of user information, which is stored in a relational database on a networked server. The personal contact manager system allows each user to specify on an individual basis which of their contacts are permitted to access respective data of their user information. In some cases, and assuming permission is granted, the system will issue notifications (e.g., by e-mail) to a user's contacts when the user changes his information or when a preset event, such as a birthday, as defined by the user, is to occur. The system also allows users to find contacts based on common group affiliations and notifies users when there are coincidences in their data (e.g., travel plans, astrological compatibility). The personal contact manager system supports the retrieval of information on the contacts of contacts, assuming such as permission has been granted by the contacts and their contacts, and can also be used to synchronize the server database with a PIM database of the user and any contacts of the user who have the appropriate permissions (See abstract).

US Patent 4,782,521 to Barlett discloses a time manager for a personal terminal generally characterized as a things-to-do file in which the user inputs a to-do reminder message along with a data and time that the terminal user wants to be alerted (reminded). The notion of a terminal time manager is advanced by displaying reminder messages directed to calling a named entity that is contained in the terminal telephone directory and by automatically calling the named entity when the user points to the displayed reminder. If the user inputs the actual telephone

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number to be called in place of the named entity, then the telephone number will be called even though the telephone number is not contained in the directory (See abstract).

US 2004/0174966A1 to Koch discloses methods, systems and products for providing communication services. One method receives a communication from an originating party, with the communication intended for a receiving party. A database of pre-created data messages is accessed, with the database storing a pre-created data message having a common association between the receiving party and the originating party. The pre-created data message is then communicated.

US2002/0169835A1 to Paul, JR. discloses an Internet-based method of communicating that interacts with a plurality of members each having a computer-based communications system with an e-mail facility. The method of communicating, in one embodiment, includes a web-based user interface for data input of member data. The member data includes communications data (e-mail address) for each member, and demographic data or personal data regarding each member. The member data is organized to a data structure such as database. An e-mail communication is prepared and a command sequence including a hyperlink to a first web site and referral communications data packet associated with the hyperlink is embedded in the e-mail. Upon actuation of the hyperlink by the member, the referral data packet is sent to a second web site. The referral data packet includes one or more data elements such as sponsor data, recipient member data, e-mail campaign data and sometimes action member data. The computer-based

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method of communicating prepares a list of members and broadcasts the communication to members based upon the list. A report is made of the receipt of referral communications data packet. The method of communicating can be enhanced to encompass a multi-modal method of communicating wherein some members have pagers, cellular telephones and/or land-line telephones. If some members do not respond to the initial e-mail communication, the computerized multi-modal method generates a digital version of an audio communication (to be presented over the cellular telephones and land-line telephones) and a paging message (to be presented to pagers) and to fax machines.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

10/20/04

JDJ

Jean D. Janvier

Patent Examiner

Art Unit 3622

J. JANVIER
SENIOR EXAMINER
Jean D. Janvier